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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1943

No. 204

MEAD JOHNSON & COMPANY,
Petitioner,

vs.

HILLMAN'S, INC.
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

This brief is submitted in behalf of the Respondent here, appellee below in the United States Court of Appeals for the Seventh Circuit, and defendant in the District Court of

the United States for the Northern District of Illinois, Eastern Division.

The Opinions of the Courts Below

This suit was brought by Petitioner for infringement of Johnson, *et al.*, United States Patent No. 1,990,329. The District Court held the claims in issue to be invalid and dismissed the complaint, the opinion of the District Court appearing in the Record at page 426 et seq. and reported in 55 U. S. P. Q., 6. The Circuit Court of Appeals for the Seventh Circuit affirmed the judgment of the District Court, the decision appearing in the Record at page 478 et seq. and also reported in 135 Fed (2d) 955, and 57 U. S. P. Q., 448. Petitioner herein filed in the Seventh Circuit Court of Appeals a petition for rehearing, which was denied by that court without opinion on July 6, 1943 (Rec. 487).

Jurisdiction

There is no question of a conflict between the Circuits as to the validity or scope of the patent involved in this suit, and the primary reason advanced for the issuance of a Writ of Certiorari herein is that the decision of the Seventh Circuit Court of Appeals enunciates a rule of law at variance with the law as laid down by this Court and by other Circuits.

Statement of the Case

The two claims here in suit are product claims, numbers 5 and 6 of the Johnson et al patent (Rec. 445). Those claims, stripped of their technical verbiage, cover essentially a precooked, dry cereal product which, upon the addition of a liquid, will form a mush or porridge. One of the claims,

number 5, recites that the product is "suitable for infant feeding".

A generally similar product was old in the art long prior to the patent in suit as evidenced by the well known "Zwieback" and "Holland Rusk" of common knowledge, the manufacturers of which suggested that a mush for infant feeding could be formed by crumbling such products and adding thereto a liquid. Both the lower Courts therefore held that the claims in suit are invalid because the product defined thereby did not involve a patentable invention over the general knowledge in the cereal art (Rec. 430, 483).

The Petitioner asserts for its patented product certain properties which are not present to the same degree in Zwieback and Holland Rusk, and which properties are alleged to arise out of the particular method of manufacturing the patented product.

However, two of the prior art patents, Braunbeck U. S. Patent No. 1, 011, 730 (Rec. 462-464) and Braunbeck British Patent No. 9528 of 1906 (Rec. 465-467), disclose a process for treating grains in substantially the same way as the process of the patent in suit, and the District Court and the Seventh Circuit Court of Appeals so held (Rec. 430, 480). These Courts consequently held that the Braunbeck product was the same in all patentable respects to the product defined by the claims here in suit, and that those claims are therefore invalid (Rec. 430, 483).

The principal reason advanced for the issuance of a Writ of Certiorari herein is that the Seventh Circuit Court of Appeals in its decision laid down and followed an erroneous rule of law, in conflict with the law as enunciated by this Court and by the Circuit Court of Appeals for the First, Third and Sixth Circuits. Specifically, the Petitioner contends that the Circuit Court of Appeals in the present case held that an unobvious advantage of a patented product

may be disregarded unless such advantage is recited in the patent claims.

The Respondent's position is that there is no conflict between the decision of the Circuit Court of Appeals herein and the law as enunciated by this Court and by the other Circuits, *because the Seventh Circuit Court of Appeals did not enunciate any such rule of law as the Petitioner seeks to attribute to that Court's opinion.**

Summary of Argument

1. The Seventh Circuit Court of Appeals did not hold that an advantage not described in the claims of a patent is to be disregarded. On the contrary, the Court explicitly held that even if the alleged unobvious advantage asserted for the patented product had been recited in the claims in suit, patentability could not be predicated thereon inasmuch as it would be merely a "functional statement".
2. In reaching its decision that the claims in suit are invalid, the Seventh Circuit Court of Appeals gave due consideration to the alleged unobvious advantage asserted for the patented product—its ability to hold a high ratio of liquid in suspension (*i. e.* its ability to absorb a large quantity of water). In evaluating the anticipatory effect of the prior art Braunbeck patents, the Court found that those pat-

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*This renders superfluous any discussion of the decisions of this Court and of the Circuit Court of Appeals of the First, Third and Sixth Circuits with which Petitioner contends (Petitioner's Brief, page 9) the decision herein of the Circuit Court of Appeals conflicts. However, it is to be noted that in each of the cases cited by the Petitioner the claims there involved defined a **novel** structure, not found in the prior art. Such is not the fact in the instant case, where the claims in suit read squarely on the Braunbeck product.

ents disclose and teach the public the very advantage in a similar product which Petitioner urges is now "unobvious" in the patented product.

3. The Seventh Circuit Court of Appeals, upon sound reasoning, properly affirmed the District Court's findings that the claims in issue are invalid (a) because of anticipation by the Braunbeck British and American patents and (b) because of lack of invention over the general prior art.

Argument

1. The Circuit Court of Appeals for the Seventh Circuit Did NOT Hold That an Unobvious Advantage Asserted for a Patented Product May be Ignored If the Claims Do Not Functionally Recite That Advantage.

To support its assertion that the Seventh Circuit Court of Appeals in its opinion in this case erroneously stated an important proposition of patent law, in conflict with the law as enunciated by this Court and by other Circuits, the Petitioner unroots from one paragraph of the opinion a single sentence, adds it to a preceding paragraph, and thereby imputes to the transplanted sentence a meaning different from that intended by the Court. The sentence relied upon by the Petitioner appears in italics in the following quotation appearing at page 10 of the Petitioner's brief:

> "Plaintiff also contends that an unobvious advantage of 'Pablum'* is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid. *It will be enough to say that the claims make no mention of this property.*"

*Product manufactured by Petitioner, and which is an embodiment of the claims in suit.

Relying upon this sentence, Petitioner asserts that the Court disregarded an unexpected advantage "because it was not functionally stated in the claims" (Petitioner's brief p. 10). This is not correct as readily appears when the sentence is read in its proper relation to the context of the paragraph in which it actually appears. The real language of the Court was (Rec. 481):

> "Plaintiff also contends that an unobvious advantage of 'Pablum' is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid.
>
> "It will be enough to say that the claims make no mention of this property. All that the Johnson patent says about fluid absorptive properties of the product is that the material has 'extremely quick' fluid absorptive properties. Even if the claims did recite that the product was characterized by its ability to hold a very high ratio of liquid, patentability could not be predicated theron, since the ability to absorb a large amount of water is merely a broad statement of an attribute or function of the product, and the rule is that functional statements cannot be availed of to define over the prior art. *General Electric Co. v. Wabash Applicance Corp.,* 304 U. S. 364."

It is clear from the entire foregoing quotation, and from the context of the opinion as a whole, that the Court did not enunciate as a rule of law that an alleged unobvious advantage of a patented product is to be disregarded "because it was not functionally stated in the claims", or, stated conversely, that an unobvious advantage must be "functionally stated in the claims" before a Court can consider such advantage. Indeed, in the last sentence of the quotation, the Court explicitly stated that, even if such a functional statement had been included in the claims, that

statement would have been of no significance in determining the validity of the claims.

2. The Circuit Court of Appeals Did Consider the Alleged Unobvious Advantage of the High Ratio of Liquid Absorption Asserted for the Patented Product.

Further evidence that the decision of the Circuit Court of Appeals does not stand for the proposition that an unobvious advantage must be recited in the claims is to be found in the fact that that Court did consider the alleged high ratio of liquid absorption asserted for the patented product.

Throughout the proceedings in the courts below, the Petitioner's principal argument for the validity of its patent here in suit was its alleged unobvious advantage residing in the absorption of a large quantity of liquid by the patented product. Both the District Court and the Circuit Court of Appeals for the Seventh Circuit obviously considered this argument, and the Circuit Court of Appeals in its opinion lists this argument specifically (Rec. 481) when it said:

> "According to Johnson et al they were the first to originate and develop a process which produced a mush which is lump-free, *holds a high ratio of liquid in suspension,* is readily digestible and which can be instantly prepared for the baby." (Italics supplied.)

The Court then immediately, in the next sentence, states the problem with which it is confronted:

> "The question we are called upon to solve is whether the prior patents disclose such characteristics and advantages and taught the art what Johnson teaches, thus

determining whether what Johnson accomplished amounts to invention."

And the Circuit Court of Appeals specifically found that the prior art *did* disclose a cereal product which "holds a high ratio of liquid in suspension", In its opinion (Rec. 480), the Court discusses the United States and British Braunbeck patents and therein points out that their thoroughly cooked and dried cereal flour "immediately absorbs a great quantity of water when brought into contact therewith". This finding not only answers the Petitioner's assertion herein that the Circuit Court of Appeals did not consider the alleged unobvious advantage, but also completely disposes of the Petitioner's entire argument with respect to that advantage—we have here an explicit holding by that Court that *the prior art discloses the very advantage which the Petitioner urges is now "unobvious."*

3. The Seventh Circuit Court of Appeals, Upon Sound Reasoning, Properly Affirmed the District Court's Finding That the Claims in Issue are Invalid.

The Petitioner urges, as a supplementary ground for the issuance of a Writ of Certiorari, that the Seventh Circuit Court of Appeals erroneously held the claims in suit invalid "when said patent represents a great advance in the art of infant feeding, and, in fact and law, is valid" (Petition, page 3). A brief review of that Court's opinion is therefore necessary, in order, to show the manifest soundness of its holding that the claims are invalid.

With reference to the anticipatory effect of the prior Braunbeck Patents, the Court of Appeals summarized the disclosure of those patents as follows (Rec. 480):

"Those patents, British Patent No. 9528 issued October 11, 1906, and United States Patent No. 1,011,730

issued December 12, 1911, disclose and describe a thoroughly cooked and dried flour (cereal product) produced by crushing the grain, the product leaving the rollers in the form of disintegrated flakes which are then reduced by a milling process to flour which swells and immediately absorbs a great quantity of water when brought into contact therewith."

The Petitioner admits (Rec. 480) that the product leaving the rollers in the Braunbeck process is the same as the patented product here in suit, but has contended throughout that this material from the Braunbeck rolls does not anticipate the claims in issue because it is only an "intermediate" product, is unappreciated, and that the Braunbeck Patents do not teach the use of the material as an infants' food nor its advantages as such a food (primarily its "high ratio of liquid absorption" discussed *supra*).

The Petitioner cited certain decisions in support of this contention. The Seventh Circuit Court of Appeals distinguished the facts of those cases from the facts here involved on the ground that the intermediate products in those cases were unknown to, and unappreciated by, the patentees and the public, whereas such was not the fact in the present case. After pointing out the manner in which Braunbeck disclosed the nature of his intermediate product, the Court concluded (Rec. 483):

"As we have already noted, the Johnson product is the same as the Braunbeck drum product, and since Braunbeck clearly and sufficiently described the essential characteristics of his product, it seems to us that with the knowledge disclosed by Braunbeck, one skilled in the art had a guide or chart enabling him to appreciate and recognize the new use of the Braunbeck product. *Berlin Mills Co. v. Proctor & Gamble*, 254 U. S. 156."

The foregoing suffices to show that the decision of the

Seventh Circuit Court of Appeals is in complete accord with the conclusion of the District Court, which held (Rec. 430):

> "The process described in the Braunbeck patents is substantially the same as the process set forth in the Johnson patent, and the Braunbeck product, therefore, is necessarily the same as plaintiff's product * * * * * * * * * While the Braunbeck patents refer to grinding the product from the rolls to form a flour and the patent in suit does not call for grinding after drying, the products from the rolls of the British and United States Braunbeck patents, both before and after grinding, are, in the court's opinion, identical in all patentably significant respects to the defendant's and plaintiff's products, respectively, and both Braunbeck patents accordingly anticipate."

As previously stated, both of the lower courts also held the claims in suit to be invalid in view of the general knowledge of the art. As stated by the District Judge (Rec. 430):

> "Furthermore, disregarding the Braunbeck Patents, the Court is of the opinion that the patent in suit does not disclose invention over general knowledge of the art. The manufacturers of Zwieback and Holland Rusk recommend that their products may be crumbled or ground and mixed with milk or water to form a gruel or mush for infant feeding. Professor Anton J. Carlson, of the University of Chicago, testified that these two products are a fit infant's food and would be readily digestible by the normal infant. * * * * *

The Court of Appeals affirmed this holding of the District Court (Rec. 483) and cited in support thereof the case of *Cerealine Mfg. Co. v. Bates,* 101 Fed. 272, 281 (C. C. A. 7th, 1900), where it was said, "Growth of the art of cereal foods, unless something distinctively new *in specie* is contributed,

is the growth of common public thought, and, therefore, independently of the process * * * belongs to the public."

It is clear, therefore, that the Circuit Court of Appeals for the Seventh Circuit, upon sound reasoning, properly affirmed the findings of the District Court that the claims in issue were invalid because of the Braunbeck patents and because of the general knowledge in the cereal art.

Conclusion

There is nothing in this case to warrant the issuance of a Writ of Certiorari. In deciding this case the Seventh Circuit Court of Appeals followed the law as laid down by this Honorable Court, and there is no conflict between the decision below and that of any of the several Circuit Courts of Appeal.

The District Court in its memorandum opinion recites fully its reasons for holding the Johnson et al patent invalid. The review by the Seventh Circuit Court of Appeals was thorough and complete. All arguments here presented were before that Court, and it properly concluded that the District Court's decision was correct and should be affirmed.

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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